

Remarks

A. Pending Claims

Claims 583-588, 590-624, and 1691-1695 are pending. Claims 600-624 are allowed. Claim 583 has been amended to include the features of claim 589. Claim 589 has been cancelled without prejudice. Claims 588, 598, and 623 have been amended for clarification. Claims 1691-1695 are new. No new matter has been added.

B. The Claims Are Not Anticipated by Carter et al. Pursuant To 35 U.S.C. §102(b)

Claims 583, 584, 586, 590, 592, and 599 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,256,945 to Carter et al. (hereinafter "Carter"). Applicant respectfully disagrees with these rejections.

The standard for "anticipation" is one of fairly strict identity. To anticipate a claim of a patent, a single prior source must contain all the claimed essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q.81, 91 (Fed.Cir. 1986); *In re Donahue*, 766 F.2d 531, 226 U.S.P.Q. 619, 621 (Fed.Cir. 1985).

Claim 583 has been amended to include the features of dependent claim 589. Claim 589 was identified in the Office Action being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Amended claim 583 describes a combination of features including: "wherein the heater is configured to be placed in an opening in a subsurface formation." The cited art does not appear to teach or suggest at least the above-quoted feature of claim 583. Applicant respectfully requests removal of the anticipation rejection of claim 583 and the claims dependent thereon.

Applicant submits, in addition, that some of the claims dependent on claim 583 are separately patentable.

Claim 584 describes a combination of features including: “wherein the electrical conductor is formed by a coextrusion process that combines the ferromagnetic material and the non-ferromagnetic material.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 584, in combination with the other features of the claim.

Claim 586 describes a combination of features including: “wherein the conduit comprises electrically conductive material.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 586, in combination with the other features of the claim.

Claim 590 describes a combination of features including: “wherein a resistance of the ferromagnetic material decreases above the selected temperature such that the heater provides the reduced amount of heat above the selected temperature.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 590, in combination with the other features of the claim.

Claim 592 describes a combination of features including: “wherein the selected temperature is approximately the Curie temperature of the ferromagnetic material.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 592, in combination with the other features of the claim.

Claim 599 describes a combination of features including: “wherein the non-ferromagnetic material comprises copper.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 599, in combination with the other features of the claim.

C. The Claims Are Not Obvious Over Carter Pursuant To 35 U.S.C. §103(a)

Claims 585, 593, and 597 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Carter. Applicant respectfully disagrees with these rejections.

To reject a claim as obvious, the Examiner has the burden of establishing a *prima facie*

case of obviousness. *In re Warner et al.*, 379 F.2d 1011, 154 U.S.P.Q. 173, 177-178 (C.C.P.A. 1967). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP § 2143.03.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). For at least the reasons cited above in Section B, Applicant respectfully requests removal of the rejection of claims 585, 593, and 597.

Applicant submits, in addition, that some of the claims dependent on claim 583 are separately patentable.

Claim 585 describes a combination of features including: “wherein the centralizer comprises silicon nitride.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 585, in combination with the other features of the claim.

Claim 593 describes a combination of features including: “wherein the ferromagnetic material comprises iron.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 593, in combination with the other features of the claim.

Claim 597 describes a combination of features including: “wherein at least a portion of the heater is longer than about 10 m.” The cited art does not appear to teach or suggest at least the above-quoted features of claim 597, in combination with the other features of the claim.

D. Claims 589 and 598 Have Been Substantially Rewritten in Independent Form

The Office Action states that claims 587-589, 591, 594-596, and 598 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

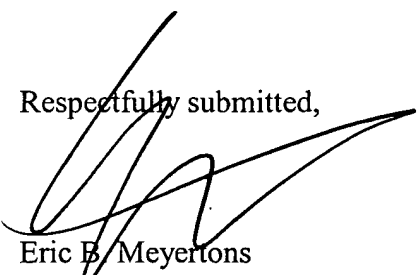
Claim 583, and the claims dependent on claim 583 (claims 584-588 and 590-599), now include features from claim 589. Claim 598 has been rewritten in independent form as new claim 1691. The claims dependent on claim 1691 (claims 1692-1695), include features from claims 586, 592, 593, and 599. Thus, Applicant believes no new search is required for the new claims.

As such, Applicant submits that all the claims, including the new claims, are in condition for allowance.

E. Comments

A fee authorization is enclosed to cover fees for the new claims. If an extension of time is required, Applicant hereby requests the appropriate extension of time. If additional fees are required or if any fees have been overpaid, please appropriately charge or credit those fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account Number 50-1505/5659-21200/EBM.

Respectfully submitted,


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